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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/678,619	10/02/2000	Gregg Motsenbocker		4452

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EXAMINER

WINTER, GENTLE E

ART UNIT PAPER NUMBER

1746

DATE MAILED: 07/17/2003

26

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/678,619

Applicant(s)

MOTSENBOCKER, GREGG

Examiner

Gentle E. Winter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 May 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4,8-35,41,43-45,47-49 and 53-58 is/are pending in the application.
- 4a) Of the above claim(s) 41,43-45,47-49 and 53-58 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 8-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## **DETAILED ACTION**

### ***Specification***

1. The objection to the use of trademarks is not withdrawn. Generic terminology is not the same as general class. Applicant may wish to consider either enumerating the active ingredients of the recited trademarked cleaners, or omit the trademark altogether. Additionally, numerous trademarks remain uncorrected. Including BELMAY LEMON, CALUMET and others.
2. The rejection is repeated for applicant convenience: The use of the trademark has been noted in this application. It should be CAPITALIZED wherever it appears and be accompanied by the generic terminology.
3. Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks. Common-law trademark rights shall be respected, as well as registered trademarks.

### ***Response to arguments***

4. Applicant's argument that "graffiti remover" is a generic term for the indicated product is accepted, to the extent that such is an indicated use. However an indicated use is not the same as disclosing a composition. It further appears that there may have been additional new matter added. The mere recitation of potential uses of a product does not identify the product in any meaningful way.
5. With specific respect to the arguments made regarding the anticipation rejection of claim 1, the provided reference fully and completely describes the subject matter *claimed*. In fact the

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claim limitations are met by many commercially available motor fuels. At page 24, applicant makes much of the fact that CAS#6474-47-8 (light hydrotreated petroleum distillates) and CAS#8008-20-6 are “different solvents.” Applicant then points to physical properties such as boiling points (complete overlap), density (complete overlap), auto ignition temperature 236 versus 220 C, explosive limits (vol% in air) 0.6-5.5 versus 0.7-5. The differences are slight, and as was acknowledged, the two chemicals are NOT THE SAME. But the broader (kerosene) subsumes the narrower (light hydrotreated petroleum distillates) and the claim uses open claim language “comprising”. If applicant wants to claim certain physical characteristics those characteristics must be present in the claim, and not present in the prior art of record. When the prior art of record and the claimed subject matter are the same, the claim is properly anticipated.

6. Kerosene is a complex mixture of hydrocarbons, blended to meet standardized product specifications. Composition varies greatly and includes C9 to C16 hydrocarbons with a boiling range of about 148-288 degrees C. See T.W. Brown Oil Co. MSDS.

***Claim Rejections - 35 USC § 112—Withdrawn and New***

7. Applicant's arguments/cancellations have overcome/obviated the rejections made pursuant to the second paragraph of this section.

8. Claims 26-35 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed

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invention. Specifically, the claimed ranges do not appear to be supported in the specification as originally filed.

***Claim Rejections - 35 USC § 102—Maintained, Withdrawn, and New***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by the MSDS for kerosene (MSDS). Claim 1 discloses “a first solvent” and a “carrier solvent that is Light Hydrotreated Petroleum Distillates.” Light Hydrotreated Petroleum Distillates is construed as the formulation defined by CAS 64742-47-8. Kerosene contains petroleum distillate, aliphatic, which is 64742-47-8. It is wholly irrelevant that applicant may be able to find a different definition.

With respect to claim 2. Since the composition is disclosed as including 1% xylene claim 2 is identically anticipated.

Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by the LOCTITE Technical Data Sheet Product 7063 (7063), disclosing: “Blend of hydrocarbon solvent, aliphatic alcohol and Methylal”.

3. Claims 8-10, 12, 14, and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by the United States Patent No. 4,306,989 to Motsenbocker ('989).

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9. Claim 8 discloses a first solvent and a carrier solvent disclosed as "Light Hydrotreated Petroleum Distillates". Light Hydrotreated Petroleum Distillates is construed as the formulation defined by CAS 64742-47-8 which is a component, including the only component of straight run kerosene.

10. With respect to claim 8, '989 discloses a mixture that includes kerosene, water and a solvent at *inter alia* column 3, line 35 *et seq.*

11. With respect to claim 9, disclosing an additive the same is disclosed at *inter alia* column 3, line 35 *et seq.*

12. With respect to claim 10, further limiting claim 9 and disclosing that the additive is halogenated second solvent, the same is disclosed at *inter alia* column 3, line 35 *et seq.* i.e. trichloroethylene.

13. As to claim 12, further limiting claim 9 and disclosing that the additive is a cleaner. The halogenated solvent is a cleaner, similarly so is the surfactant see *inter alia* column 3, line 35 *et seq.*

14. As to claim 14, disclosing that the additive is a fragrance, the same is disclosed *inter alia* column 3, line 35 *et seq.* e.g. lemon oil. In a larger sense anything with an odor is a potential fragrance.

15. As to claim 15, further limiting claim 9 and disclosing 0.1-50 wt% first solvent, and carrier solvent 10-99.9 wt% the same is identically disclosed at see *inter alia* column 3, line 35 *et seq.*

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***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over '989 as set forth above and United States Patent No. 6,342,471 to Jackson ('471). Each and every limitation of claim 11 is disclosed in '989 as set forth above, except that '989 fails to explicitly disclose the particular halogenated solvent n-propyl bromide. The '471 reference explicitly discloses this solvent and explicitly provides the motivation for the instant combination. Specifically, brominated solvents, and most preferably n-propyl bromide, have excellent characteristics for use as a cleaner. The '471 reference continues, "brominated solvents have been found to have good solvency and little to no flammability." The artisan would have additionally been motivated to make the instant combination for the additional reason set forth in the '471 reference, namely:

As will be recognized by those skilled in the art, the lower the value of the ODP, the lower the adverse effect on the stratospheric ozone. To this end, it has been found that nPB has a low ODP, that is predicted to be about 0.002 to about 0.03 in a concentrated form. Most advantageously, the ODP of the cleaner is even lower when the nPB is in the final cleaner formulation.

3. Claims 13, and 16-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over '989 as set forth above and United States Patent 4,260,510 ('510) to Hey et al. Each and every limitation of claim 13 is identically disclosed in '989 as set forth above, except that '989 fails to explicitly disclose the particular cleaner is ethanol. The '510 patent teaches that it is well known

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that azeotropic mixtures of solvents or mixtures approximating thereto can be employed as cleaning liquids. Such mixtures often comprise 1,1,2-trichloro-1,2,2-trifluoroethane as a primary solvent and a co-solvent. The latter may be selected from a very large number of solvents including by way of example...methylal...and lower aliphatic alcohols, for example, ethanol. The artisan would have been motivated to include ethanol because of its good solvating action, water solubility and bactericidal properties.

4. As to claims 16, 17, 19-24 further limiting claim 15. Each and every limitation of claim 16, 17, 20, and 22-24 are identically disclosed in '989 as set forth above, except that '989 fails to explicitly disclose that the first solvent is methylal. The '510 reference teaches methylal, and provides the motivation for making the instant combination. Specifically, methylal is disclosed to be effective for removing adherent deposits. See *inter alia* see e.g. column 1, line 10 *et seq.* In a larger sense, methylal is a common solvent additive (see the Loctite reference above) it is especially liked because of its status from an environmental perspective. Additionally, the artisan would have been motivated to augment the cleaning composition with methylal because it is both hydrophilic and lipophilic, and its low viscosity and surface tension associated with its high solvent power make it an excellent component for many applications. The concentration of methylal, to be effective, would have to be at least 0.1%.

With respect to claim 19, the fragrance is in '989 see e.g. column 3, line 27 *et seq.*

5. With specific respect to claims 18, 21, and 25, and disclosing 6.2% methylal, 92% petroleum distillates, 0.8% ethanol and 1% fragrance and 11.9% methylal, 71.3% water, and 0.8



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EtOH and 2.7% of a common surfactant (see below with respect to octylphenoxypolyethoxyethanol, a common and widely used surfactant). The recitation is contemplated by the references but is not identically disclosed. Nonetheless, the mere recitation highly specific concentrations will not impart patentability to an otherwise unpatentable composition. Under some circumstances, however, changes such as these may impart patentability to a process if the particular ranges claimed produce a new and unexpected result which is different in kind and not merely degree from the results of the prior art, such ranges are termed critical ranges and the applicant has the burden of proving such criticality. It has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Waite*, 77 USPQ 586 (CCPA 1948); *In re Scherl*, 70 USPQ 204 (CCPA 1946); *In re Irmischer*, 66 USPQ 314 (CCPA 1945); *In re Norman*, 66 USPQ 308 (CCPA 1945); *In re Swenson*, 56 USPQ 372 (CCPA 1942); *In re Sola*, 25 USPQ 433 (CCPA 1935); *In re Dreyfus*, 24 USPQ 52 (CCPA 1934).

Concentration limitations are obvious absent a showing of criticality. *Akzo v. E.I. du Pont de Nemours* 1 USPQ 2d 1704 (Fed. Cir. 1987).

6. Claims 26-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over '989 see e.g. column 3, line 27-33, and 65 through column 4, line 8. Disclosing the claimed ranges.

### ***Conclusion***

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gentle E. Winter whose telephone number is (703) 305-3403.

The examiner can normally be reached on Monday-Friday, 8:30-5:00.

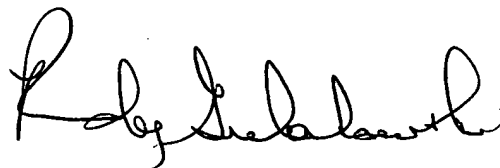
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy P. Gulakowski can be reached on (703) 308-4333. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Gentle E. Winter  
Examiner  
Art Unit 1746

July 14, 2003

A handwritten signature in black ink, appearing to read 'Randy Gulakowski', with a stylized, cursive script.

RANDY GULAKOWSKI  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1700